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EXAMINER

STORMER, R

ART UNIT

PAPER NUMBER

3617

DATE MAILED: 08/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/775,425

Applicant(s)
Chase et al

Examiner
Russell Stormer

Art Unit
3617



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Aug 13, 2001

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-11, 13-25, 27, and 28 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-11, 13-25, 27, and 28 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on Feb 1, 2001 is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

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Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “margin” of claim 1; adhesive being in the form of a mechanical interlocking means as set forth in claims 7 and 21; and the composite wheel of claims 12 and 26 must be shown or the feature canceled from the claims. **No new matter should be entered.**

Applicant has argued that it would be impractical to show the “margin” because the drawings are not dimensional but exhibit features of the invention.

This is not understood because the showing of the “margin” would merely require a line be drawn near the flange lip of the wheel.

While the use of the term “adhesive” is understood to include a mechanical connection, the term “mechanical interlock means” implies some additional structure other than adhesive which is interlocked, and such structure must be shown in order to understand the invention.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "30" has been used to designate different embodiments of the wheel rim, and the reference character 38a has been used to designate different rim flanges. Each of the different wheel rims and rim flanges should be designated with a different character such as 38a, 38a', 38a'', etc.

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Further, since each embodiment of the overlay is different than the next, reference characters such as 50, 58, and 58a should be designated to differentiate between the different embodiments.

Correction is required.

Specification

3. The specification is objected to under 37 CFR 1.75(d)(1) as failing to provide proper antecedent basis for the claimed subject matter. There is no description of the mechanical interlocking adhesive means as set forth in claims 7 and 21.

See and MPEP § 608.01(o). **No new matter should be entered.**

4. The specification is objected to because of the following informalities: On at least pages 16, 23, and 24 the term "net" is used in what appears to be the wrong context. In some of the instances it appears that the word --next-- was the intended word; but in other instances, such as on pages 23 and 24 the use of the term "net" does appear to make sense.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 6, 7, 14, 20, 21, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claims 7 and 21, it is not clear how the adhesive "is a mechanical interlocking means." Adhesives are generally considered to be chemical locking means.

Claims 14 and 28 are indefinite because the term "is shaped" to accommodate a balance weight does not define any structure which could receive, accommodate, or allow the attachment of a balance weight, and it is impossible to know what the limitations of the claim are.

6. Claims 14 and 28 are too indefinite to examine on the merits.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

8. Claims 1, 7, 10, 11, 15, and 21, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Todd.

As shown in figures 2 and 4b the peripheral lip of the overlay substantially cover the flange lip of the rim but does not extend beyond the outermost edge of the flange lip of the rim.

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With respect to claims 7 and 21, the adhesive overlay is considered to provide a mechanical interlock of the wheel and the overlay inasmuch as the claimed interlock is mechanical.

9. Claims 1, 4, 5, 8, 10, 11, 15, 18, 19, 22, 24, and 25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Eikhoff.

As shown in both figures 4 and 5, the overlay includes a peripheral lip which substantially covers, but does not extend beyond, the outermost edge (periphery) of the rim flange lip.

10. Claims 1, 10, 11, 15, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Buerger.

As shown in figures 3 and 4, the wheel cover includes an outermost peripheral lip which substantially covers, but not extend beyond, the outermost edge of the rim flange.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

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and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 2, 3, 8, 9, 16, 17, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd.

Todd meets all of the limitations of claims 1 and 15 as set forth in paragraph 10 above. The tolerances and the margins between the lip of the overlay and the flange lip would have been obvious as design or mechanical expedient since those of ordinary skill in the art could readily determine suitable tolerances.

For the overlay to comprise a heat-resistance paint finish, a metal-plated finish, or no finish all would have been obvious as such are well-known in the art and one of ordinary skill could decide which finish is desired.

13. Claims 2, 3, 6, 8, 9, 10, 13, 16, 17, 20, 23, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eikhoff.

Eikhoff meets all of the limitations of claims 1 and 15 as set orth in paragraph 11 above.

The tolerances between the lip of the overlay and the flange lip are design expedients obvious to those of ordinary skill in the art.

To substitute double-sided adhesive tape for the adhesive 70 of Eikhoff would have been obvious as a functional equivalent.

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To use a metal-plated finish, a heat resistant paint finish, or no finish at all would have been obvious to those of ordinary skill in the art as design expedients as all of these finishes are well-known in the art.

As shown in figure 5, it is obvious that the rim flange and the overlay could accept an industry standard balance weight.

Response to Arguments

14. Applicant's arguments filed August 13, 2001 have been fully considered but they are not persuasive.

Applicants' arguments that the patents to Todd, Eikoff, and Buerger do not anticipate the claims is not understood since they clearly show the overlays to at least substantially cover the outer lip of the rim flanges, but the outer edges of the overlays do not extend beyond the rim flange lips. In other words, the diameters of the overlays are substantially the same, but not greater than the diameters of the rim flanges.

The summation of the teachings of the patent to Todd as an "incidental suggestion" in the second paragraph of page 12 of the response is offensive to the patent system and does not advance the prosecution of the application. Moreover, Todd is not silent on the positioning of the overlay on the wheel. The drawings clearly show the outer edge of the rim to be covered by the outer periphery of the overlay and further show that the overlay does not extend beyond the rim flange.

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Conclusion


15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-1113.

rds

August 20, 2001


RUSSELL D. STORMER
PRIMARY EXAMINER 8/20/01